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January 15, 2004

AP
3714
Hg / Appeal Brief
LW/Maya -
2/6/04

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TECHNOLOGY CENTER R3700

Re: Application No. 10/031,776 - Notice of appeal and brief in support

Dear Sir/madam,

Attached are notice of appeal for application No. 10/031.776, and brief in support of the appeal in triplicate.

I have already sent both the appeal and the brief more than a month ago, together with payments in a pto-2038 forms. The payments were taken from my Visa account on December 11, 2003. However, the appeal and the brief are not recorded yet on the file. I checked both by PAIR and by calling the receptionist of Art unit 3714. I did not succeed to get an answer from the examiner or his supervisor. I therefore assume that the documents got lost and hence send them again. I attach a photocopy of my Visa Card Account statement, on which the transaction appear, as a prove for the payment.

As the deadline for response is very close by now, can you please confirm receipt of this letter by a fax to +44 1223 257812, marked "for Yehouda Harpaz".

Thanks,

Yehouda HARPAZ



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November 30, 2003

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Re: Application No. 10/031,776 - Brief of appeal

1) *Party of interest:* Yehouda Harpaz (sole inventor).

2) *Related appeals and interferences:* There are no related appeals or interferences.

3) *Status of claims:* Claim 1 - Rejected.

Claims 2-7 - cancelled.

The appeal is against the rejection of Claim 1.

4) *Status of Amendments:* There are no amendments subsequent to final rejection.

However, Claim 1 contains a line (line 6, which reads "a character display ; and "), which is completely redundant, as the rest of Claim 1 does not refer to the character display, and this line does not contribute to the novelty of Claim 1. If it is possible to do it at this stage without delaying the appeal, I would like to delete this line.

5) *Summary of the invention:* An electronic board which is played by touching points, with a novel behaviour. The behaviour is that, except playing in turns, the sole rule is that a point is a legal move if its 'visibility' for the player is above or equal to some fixed number. The 'visibility' of a point is determined by checking in turn each of a predefined set of imaginary straight lines emanating from the point. If the line does not pass through any illuminated point, it is assigned a value of 0. Otherwise the line is assigned a value of 1 if the closest illuminated point that it passes through is illuminated in the colour of the player, or -1 if it is in the opponent's colour. The sum of the values of the lines is the 'visibility' of the point for the player. The game ends when neither of the players has a legal move, and the player with more points of his/her colour wins.

The concept of 'visibility' and its implication is discussed in the description starting at the bottom of p. 3 of the description and continues through p. 4, and is illustrated in drawings 4 and 5 (the drawings cannot be understood without the text).

6) *Issues:* The rejection of Claim 1 under the doctrine of double patenting is based on misunderstanding what Harpaz 6,568,683 claims. The rejection of Claim 1 under USC 102 (e) is based on a mis-representation of what Golad 6,231,441 says as if it contains material that it doesn't, and also doesn't take into account the full contents of Claim 1.

7) *Grouping of Claims:* Only one claim is appealed.

8) *Argument:*

(a) **General** - In the original non-final rejection of Claim 1, the examiner ignored the second half of Claim 1 (lines 12-23), arguing that they are describing rules of a game and therefore are not patentable material (non-final rejection, p.6). The argument appeared in the section

discussing rejection under USC 102, but the second-half of Claim 1 was also ignored in the preceding discussion of double patenting (section 6, p.4). Therefore, most of my response was an argument that this part is the behaviour of the board, and therefore patentable. In the final rejection, the examiner removed the argument for ignoring the second half of Claim 1, and added text that refers to the second half of Claim 1.

(b) Double Patenting

(b.1) In his description of the board which is described in Harpaz 6,568,683, the examiner includes this statement (which was not included in the non-final rejection) (p.3, lines 1-3):

“... the game manager checks for each point the illumination state of the point and of a pattern of points around to insure appropriate movement of a player...”

(b.2) This is a mis-representation of what is claimed in Harpaz 6,568,683. The check in 6,568,683 is to decide what will be the state of the point in the next period of time, and it happens each short period of time, without any relation to any player's action (Claim 1, column 8, lines 12-16). As explained in column 3, lines 53-58, this change each period of time (“generation”) is a major part of the innovation in 6,568,683.

(b.3) A board that behaves according to Claim 1 of the current application does not change the pattern of illumination periodically. It does it only when the player touches a point, and only if it is a legal move. Thus it will be outside of the scope of 6,568,683. Conversely, a board which is constructed according to the claims of 6,568,683 changes periodically, and also changes the illumination state of a point whenever a player touches it, and therefore will be outside the scope of the current application. Thus each of 6,568,683 and the current application has a scope that extends outside the scope of the other, therefore neither of them encompasses the other, and hence they are patentably distinct.

(b.4) The examiner reached the conclusion that they are not patentably distinct because he ignored the periodical changes in 6,568,683, and instead interpreted it as a restriction of players' moves. The mistake of ignoring the periodical change was done also in the non-final rejection, but I didn't realise this and therefore did not answer it.

(c) Claim rejections - 35 USC 102

(c.1) In his description of the board which is described in Golad 6,231,441, the examiner includes this statement (which did not appear in the non-final rejection) (p.4, lines 7-9, my italics):

“... and a game manager evaluating legal moves by each player by *checking in turn each of a pre-defined set of imaginary straight lines emanating from the point to evaluate a correct and incorrect move, ..*”

(c.2) The part in italics is a mis-representation of Golad 6,231,441, because there is nothing in 6,231,441 that can be interpreted this way. This part is actually lifted from Claim 1 of the current application.

(c.3) The examiner explains this mis-representation in the following text (p.4, lines 9-12):

“..., in which the examiner interprets to be in the computer informing a player on a incorrect move by flashing the correct playing areas on the grid point in straight lines, which is equivalent to applicant’s game manager evaluating legal or illegal moves by a player (column 3, line 54 - column 4, line 9).”

(c.4) I did not understand this explanation, and I don’t think it is a coherent English text, but it clearly does not contain anything to do with “checking in turn each of a pre-defined set of imaginary straight lines”. The text in 6,231,441 that the examiner refers to (column 3, line 54 - column 4, line 9) also does not contain anything that may be interpreted this way. In fact, in the example in 6,231,441 the evaluation is whether the move “traps” or borders an occupied area (column 4, lines 14-17).

(c.5) The idea that is expressed in lines 14-22 of Claim 1 of the current application (starting with “when a player touches a point...”), is a combination of the following elements:

- (1) Look at distant points beyond unilluminated points, rather than only illuminated neighbours.
- (2) Use the first illuminated point that is encountered to define the value for a direction (1 for player’s colour, -1 for the other colour).
- (3) Sum the values in all directions, rather than just checking if any of the directions fulfils some condition.
- (4) Use the result to decide if a move is legal.
- (5) Use this evaluation as the sole determination of the behaviour of the board during the game, rather than make the evaluation just part of the rules of the game.

(c.6) Of these elements, only element (4) may be regarded as mentioned by Golad 6,231,441, and there is nothing in 6,231,441 that could be interpreted as any of the elements (1), (2), (3) and (5). Therefore 6,231,441 clearly doesn’t anticipate Claim 1. The examiner reached his conclusion because he mis-represented 6,231,441 to have element (1) and (3) as shown above in (c.1) and (c.2), and ignored elements (2) and (5) altogether.

(c.7) Elements (1)-(4) can be found in earlier documents, but element (5) is completely new, and this is an important innovation, because it generates a game with simple rules but considerable strategic depth. In addition, there are no previous examples of combinations of any pair of elements (1)-(4) (Harpaz 6,568,683 may be regarded as containing both elements (2) and (3), but element (2) did not appear in the first priority document of 6,568,683 (application GB 9907163.1), only in application GB 9919551, which is also the first priority document of the current application).

(c.8) The combination of all these elements together generates a behaviour that is radically different from anything that have been published until now in any context, including all the documents that were cited by the examiner or in the international search report (excluding my other applications which may mention it, but has the same or later priority date). This is true not only in the context of electronic boards, but also video/computer games and classical games. This can be verified by scanning the catalogues of toys and games companies, for example:

<http://www.hasbro.com/games/>

or an online directory of board-games, for example:

http://directory.google.com/Top/Games/Board_Games/

<http://www.board-games-directory.com>

http://dmoz.org/Shopping/Toys_and_Games/Games/Board_Games/New/
(Note that the idea does appear in my domain, <http://maldo.com>)

(c.9) Hence the combination of the elements which are listed above in (c.5), as presented in Claim 1, is novel and inventive over anything that has been published earlier.

(c.10) As I wrote above in (a), in the non-final rejection the examiner explicitly ignored the second half of Claim 1, and therefore I didn't realise that I have to discuss it.

(d) Response to arguments

(d.1) As I wrote above in (a), the main problem in the non-final rejection was that the examiner argued that the second half of Claim 1 should be ignored. Therefore, my answer mainly dealt with this argument. Apparently the examiner was persuaded by it, because he removed his argument in the final rejection, so apparently it was persuasive.

(d.2) I did not discuss the novelty of the second half of Claim 1, because to me it is clear that it is novel, and there wasn't anything in the non-final rejection that indicated otherwise. The examiner seems not to appreciate its novelty because he read part of the novel features into the earlier patents, and ignored the rest of the novel features.

9. Appendix - Claims

1 (original) An electronic board comprising:

a grid of *grid points* on a flat surface, where each *grid point* is a visible element which is capable of detecting when it is pressed, and can be illuminated in two different colours, allocated to respective players, by an illumination source inside or below the surface; and a character display ; and

a *game manager* made of

a CPU and memory, connected electronically to the grid points and illumination sources such that it has complete control on which grid point is illuminated and in what colour, and it is notified whenever any of the grid points is pressed, and a computer program which is executed by the CPU,

which manages a one or more games, of which at least one game is played according to these rules:

when a player touches a point, the games manager checks if it is a legal move, and if it is switches the point to the player's colour;

to evaluate if a point is a legal move, the games manager checks in turn each of a pre-defined set of imaginary straight lines emanating from the point, assigning a value of 0 to each of these lines that does not pass through an illuminated point, a value of 1 if the closest illuminated point that it passes through is illuminated with the colour of the player, and -1 if it is in the opponent's colour, and then compares the sum of the values of all the lines to a fixed number, and if the sum is larger or equal the point is a legal move for the player;

the games manager declares as winner the player that has more points of their colour in the end of the game.